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1713

PATENT

Customer No. 22,852  
Attorney Docket No. 7648.0006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Yulin DENG et al.

Serial No.: 09/621,695

Filed: July 21, 2000

For: WATER SOLUBLE/DISPERSIBLE  
AND EASY REMOVAL CATIONIC  
ADHESIVES AND COATINGS  
FOR PAPER RECYCLING

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

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Group Art Unit: 1713

Examiner: D. Wilson

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RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated December 12, 2001, reconsideration of this application, in light of the following discussion, is respectfully requested.

The Examiner made a restriction under 35 U.S.C. § 121 to one of the following groups.

Group I, claims 1-25 and 66, drawn to adhesive or coating, classified in class 524, subclass 555<sup>+</sup>;

Group II, claim 26-44, drawn to a method of making an adhesive or coating, classified in class 524, subclass 555<sup>+</sup>;

Group III, claims 45-62, drawn to a method of recycling a paper product, classified in class 162, subclass 5<sup>+</sup>;

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Group IV, claim 63, drawn to a tape, classified in class 428, subclass 411.1<sup>+</sup>;

Group V, claim 64, drawn to a label, classified in subclass 428, subclass 425.1<sup>+</sup>;

and

Group VI, claim 65, drawn to a stamp, classified in class 283, subclass 71.

Applicants provisionally elect, with traverse, to prosecute, Group I, claims 1-25  
and 66.

~~The Examiner further required election to one of the following patentably distinct species:~~

- a. cationic polymer, specifically including the monomers units present in the backbone and grafted groups, if present;
- b. tacky or hot melt;
- c. tackier including the specie of none present;
- d. plasticizer including the specie of none present;
- e. cationically charged monomers;
- f. copolymerizable backbone;
- g. methods of polymerization, as set forth in claim 27;
- h. imitator including the specie of non-present;
- I cross-linker including the species of none present;
- j. water soluble monomers of macromers, including the species of none present;
- k. water present or absent; and
- l. alcohol present or absent.

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Applicants provisionally elect, with traverse, to prosecute species "a" directed to cationic polymers, specifically including the monomeric units present in the backbone and grafted polymers.

The Examiner's attention is directed to M.P.E.P. § 803, which sets forth criteria and guidelines for Examiners to follow in making a proper requirement for restriction. A restriction requirement is proper only if in the absence of restriction there is a serious burden on the Examiner in examining all of the claims. (See MPEP §§ 803.02, 806.04(a) - (j), 808.01(a) and 808.02). It would not constitute an undue burden to search the subject matter as claimed.

If the search and examination of an entire application can be made without serious burden the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803.02 (emphasis added).

The Examiner has not even addressed the burden let alone shown that there would be a "serious burden" involved in examining Groups I - VI together. Applicants submit that the search required to properly examine the elected subject matter would necessarily involve an overlapping search of the entire subject matter presently claimed, including the claims of all of Groups I-IV. For example, Groups IV-VI are directed to a tape, a label and a stamp, respectively. Claims 22, 23 and 25 which are included within elected Group I are also directed to a tape, a label and a stamp, respectively.

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of the requirement for restriction and the timely allowance of the pending claims.

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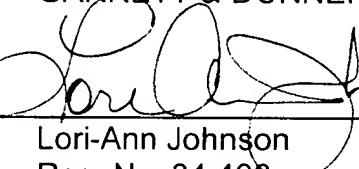
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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 14, 2002

By:   
Lori-Ann Johnson  
Reg. No. 34,498

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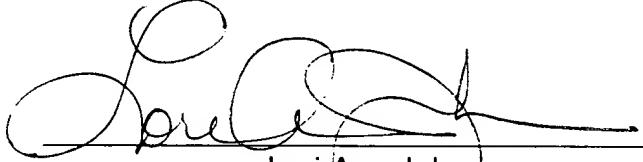


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on January 14, 2002  
Date



Lori-Ann Johnson

Enclosures:

1. Response to Restriction Requirement - 4 pages
2. Postcard

FEB 18 2002